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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,155	11/14/2003	J. Christopher Flaherty	TRNSV-029C2	2382

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MEDTRONIC VASCULAR, INC.  
IP LEGAL DEPARTMENT  
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EXAMINER
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ROZANSKI, MICHAEL T

ART UNIT	PAPER NUMBER
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3768

MAIL DATE	DELIVERY MODE
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09/03/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/714,155	<b>Applicant(s)</b> FLAHERTY ET AL.	
	<b>Examiner</b> MICHAEL ROZANSKI	<b>Art Unit</b> 3768	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 36-47 is/are pending in the application.
- 4a) Of the above claim(s) 7-12, 15-28, 46 and 47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-6, 13, 14 and 29-33 is/are allowed.
- 6) ☒ Claim(s) 34 and 36-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 1, 13, 36, and 46-47 are objected to because of the following informalities:

In claim 1, line 8, the term --the-- should be placed before the term "target"

In claim 1, line 15, "enabling" should be changed to --enable-- and the term "that" has been duplicated

In claim 13, line 11, it is unclear what is "in a known circumferential location..." Examiner suggests replacing "and" with --at least one of said transducer elements being-- and inserting the term -a- before "known"

In claim 36, "Claim 35 34" should read --Claim 34--

With respect to claims 46 and 47, it is submitted that these claims have the incorrect status identifier as they should be withdrawn.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34 and 36-45 rejected under 35 U.S.C. 103(a) as being unpatentable over Crowley in view of Seward et al, both of record, insofar as Seward et al evidences

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the obviousness of providing a circumferential locator array for an imaging transducer assembly in a penetrating tool catheter such as Crowley et al, with note that a target location as called for in the claim is any tissue situs towards which the tool is protruded including angioplasty applications in the vicinity of the vessel through which the catheter is delivered to its worksite.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 13-14, 29-34, and 36-45 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-35 of U.S.

Patent No. 6,375,615. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-35 of '615 feature a catheter, tissue penetrator, imaging transducer, and marker to enable operator to rotationally orient the catheter to indicate penetrator path. Therefore, one in possession of the

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elements of '615 would necessarily be in possession of the elements of the currently claimed invention.

Claims 1-6, 13-14, 29-34, and 36-45 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-62 of U.S. Patent No. 6,544,230. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-62 of '230 feature a catheter, tissue penetrator, imaging transducer, and marker to enable operator to rotationally orient the catheter to indicate penetrator path. Therefore, one in possession of the elements of '230 would necessarily be in possession of the elements of the currently claimed invention.

Claims 1-6, 13-14, 29-34, and 36-45 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,726,677. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-18 of '677 feature a catheter, tissue penetrator, imaging transducer, and marker to enable operator to rotationally orient the catheter to indicate penetrator path. Therefore, one in possession of the elements of '677 would necessarily be in possession of the elements of the currently claimed invention.

Claims 1-6, 13-14, 29-34, and 36-45 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-48 of U.S. Patent No. 6,190,353. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-48 of '353 feature a catheter, tissue penetrator, imaging transducer, and marker to enable operator to rotationally orient the catheter to indicate penetrator path. Therefore, one in possession of the elements of '353 would necessarily be in possession of the elements of the currently claimed invention.

Claims 1-6, 13-14, 29-34, and 36-45 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-72 of U.S. Patent No. 6,302,875. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-72 of '875 feature a catheter, tissue penetrator, imaging transducer, and marker to enable operator to rotationally orient the catheter to indicate penetrator path. Therefore, one in possession of the elements of '875 would necessarily be in possession of the elements of the currently claimed invention.

Claims 1-6, 13-14, 29-34, and 36-45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-51 of copending Application No. 10/773,836. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-51 of '836

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feature a catheter, tissue penetrator, imaging transducer, and marker to enable operator to rotationally orient the catheter to indicate penetrator path. Therefore, one in possession of the elements of '836 would necessarily be in possession of the elements of the currently claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-6, 13-14, 29-34, and 36-45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 10/549,012. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-27 of '012 feature a catheter, tissue penetrator, imaging transducer, and marker to enable operator to rotationally orient the catheter to indicate penetrator path. Therefore, one in possession of the elements of '012 would necessarily be in possession of the elements of the currently claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Allowable Subject Matter***

Claims 1-6, 13-14, and 29-33 are otherwise allowable, if the claim objections and double patenting rejections are overcome.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL ROZANSKI whose telephone number is (571)272-1648. The examiner can normally be reached on Monday - Friday, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric F Winakur/  
Primary Examiner, Art Unit 3768

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